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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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OWENS CORNING
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EXAMINER

TORRES VELAZQUEZ, NORCA LIZ

ART UNIT

PAPER NUMBER

1771

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/966,309

Examiner

Norca L. Torres-Velazquez

Applicant(s)

KRANENDONK, DIRK

Art Unit

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Period for Reply - The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 14-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-13, drawn to a fiber reinforced wall covering, classified in class 442, subclass 180.
 - II. Claims 14-21, drawn to a method of making, classified in class 427, various subclasses.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process can be used to make a laminate for use in applications such as insulation material.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with James J. Dottavio on March 31, 2003 a provisional election was made with traverse to prosecute the invention of group I, claims 1-13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 14-21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The temperature and relative humidity at which the water vapor transmission rate is measured is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 13 contains the trademark/trade name Papermatch. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a dispersion of ground calcium carbonate and ground titanium dioxide in high density polyethylene and, accordingly, the identification/description is indefinite.

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9. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites a wall covering material "requiring less paint consumption", because this limitation implies a comparison and it is not clear to what the invention is being compared, i.e., requires less paint than what? Presumably it's being compared to another wall covering, but it's not clear what type, i.e. how the comparative wall covering differs from the inventive wall covering.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

11. Claims 1, 3-5 and 11-12 are rejected under 35 U.S.C. 102(e) as being anticipated by GUNDBERG et al. (US 6,203,646).

GUNDBERG et al. discloses a method of producing a mineral fiber element comprising a mineral fiber base layer having a surface coating in the form of a fibrous netting formed of a thermoplastic polymer material wherein such a surface coating is provided on at least a part of the surface of the base layer, wherein the surface coating is formed by heating a thermoplastic polymer material so as to melt it and distributing the polymer melt obtained in the form of fibers and/or filaments on the surface of the base layer and cooling it to form a solid layer. (Abstract)

The mineral base layer may have any form and typically it has the form of an endless web, a web, a mat or a sheet. (Column 3, lines 39-40) Therefore, the mineral base layer of GUNDBERG et al. equates to the claimed non-woven fiber tissue or mat of the present invention. Further, GUNDBERG et al. also anticipates the limitations of claim 11 since it teaches the use of mineral fibers. (Above) Since the material is the same, it would inherently meet the limitation "requiring less paint..."

With regards to claims 3, 4 and 5, GUNDBERG et al. teaches the use of a surface coating with a surface weight of from 2 g/m^2 to 50 g/m^2 . It also teaches the use of thermoplastic polymer materials such as polyethylene and polypropylene. (Column 3, lines 12-35)

With regards to claim 12, the reference teaches that in order to impart sufficient strength to the non-woven material, it should have a surface weight of at least about 20 g/m^2 . (Column 1, lines 47-51)

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 2 is rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over GUNBERG et al.

It is noted that GUNBERG et al. is silent with respect to the claimed surface tension of the coating surface. However, it is reasonable to presume that the claimed surface tension is inherent to the invention of GUNBERG et al. Support for said presumption is found in the use of the same starting materials (i.e. fiber matt and thermoplastic polymer coating), like processes of making the articles (i.e., melting polymer of the matt), and the production of similar end-products (i.e., reinforced mineral fiber materials, etc...). The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the presently claimed function of surface tension would obviously have been provided as a result of the inventive corona discharge treatment taught by LAST's reference. *Note In re Best*, 195 USPQ 433.

14. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over GUNBERG et al. as applied to claims 1, 3-5 and 11-12 above, and further in view of LAST (US 1,463,671).

GUNBERG et al. is silent with respect to the claimed surface tension of the coating surface.

LAST teaches the use of corona discharge treatment on the surface of a wall covering to increase its adhesion. Since it is known that adhesion of a polymer film/coating is directly correlated to its surface tension, the Examiner concludes that the corona discharge treatment taught by LAST would inherently produce the claimed surface tension since it increases the adhesion of the surface of the film. (Column 1, lines 10-37)

15. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over GUNBERG et al. as applied to claims 1, 3-5 and 11-12 above, and further in view of PENZ et al. (US 5,888,913).

GUNBERG et al. fails to teach the use of mineral filler in the thermoplastic polymer coating.

PENZ et al. discloses glass matt reinforced thermoplastic and one of the object of their invention is to find glass matt reinforced thermoplastics with no insert visibility and that on the painted part satisfactory paint adhesion on the glass matt reinforcement thermoplastic surface is obtained without great expenditure. The reference teaches the addition of fine-particle, mineral fillers to enhance the paint adhesion. (Column 1, lines 64 – Column 2, lines 1-10)

The reference further teaches adding mineral fillers such as talc, chalk and barium sulfate at concentrations from 2 to 60% by weight to the thermoplastics. (Column 3, lines 14-18)

Since both GUNBERG et al. and PENZ et al. are from the same field of endeavor, the purpose disclosed by PENZ et al. would have been recognized in the pertinent art of GUNBERG et al.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the thermoplastic polymer coating and provide it with mineral

fillers with the motivation of obtaining a satisfactory paint adhesion on the glass matt reinforced thermoplastics as disclosed by GUNBERG et al. (Above).

16. Claims 9, 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over GUNBERG et al. as applied to claims 1, 3-5 and 11-12 above, and further in view of MELBER et al. (US 4,898,892).

GUNBERG et al. fails to teach the use of an opacifying agent such as titanium dioxide in the thermoplastic polymer coating.

MELBER et al. discloses a method for making an opaque coating comprising combining a film forming coating binder and a composite opacifier. The reference teaches the use of inorganic opacifier materials such as titanium dioxide and calcium carbonate. (Column 1, lines 36-45) On Table III, the reference teaches how the film thickness and volume of opacifier is necessary for 94% hiding. (Column 17, lines 6-23). With regards to claim 13, it is known that the trademark product Papermatch is a dispersion of ground calcium carbonate and ground titanium dioxide in high density polyethylene and the prior art of reference teaches the use of these components, the ratio or ranges of concentration of these would be an obvious cause-effective variable that will depend on the intended refractive index of the opacifying component. (Refer to claims 1 and 3)

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the coating material to contain titanium dioxide with the motivation of providing the coating with "hiding" as disclosed by MELBER et al. (Above and also refer to column 2, lines 24-26).

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17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Norca L. Torres-Velazquez whose telephone number is 703-306-5714. The examiner can normally be reached on Monday-Thursday 8:30-4:00 pm and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

nlt
April 7, 2003

Elizabeth M. Cole
ELIZABETH M. COLE
PRIMARY EXAMINER